

REMARKS

Applicant acknowledges that the previous Double-Patenting rejection is withdrawn in view of Applicants remarks. Claims 35-54 are pending.

Applicant also references the telephonic conversation with the Examiner regarding the 37 C.F.R. 1.131 declaration by James A. Hoffman, submitted on June 6, 2005 and accompanying Exhibit A submitted June 8, 2005. The Examiner indicated that the declaration and Exhibit A were not on the record and requested that they be resubmitted. Applicants indicated that the declaration and Exhibit A were found on the Patent and Trademark Office website, Public PAIRS. The Examiner later indicated that the declaration and Exhibit need not be resubmitted.

DOUBLE PATENTING REJECTION

Claims 35-38 are rejected on the ground of nonstatutory obvious-type double patenting over claims 1 and 4 of US Patent No. 6,358,924. Applicant herewith submits a terminal disclaimer over US Patent No. 6,358,924. As such, Applicant submits the rejection is moot and request withdrawal.

REJECTION OF CLAIMS 35- 54 UNDER 35 U.S.C. § 102(e)

Claims 35, 39-41 and 44-45 are rejected under 35 U.S.C. § 102(e) as anticipated in view of Knudsen et al., U.S. 6,458,924 (hereafter the '924 patent). Applicant submits that the '924 patent is not prior art against the present invention as the relied upon subject matter that allegedly anticipates the present invention was not disclosed prior to the Applicant's invention thereof.

The '924 patent claims priority to applications US 60/036,255 ('255) and 60/035,904 ('904), both filed on January 24, 1997 and also, US 60/036,226 ('226) which was filed on January 25, 1997. Applicant submits that there is no disclosure of a "tween surfactant" in these priority documents. In addition, Applicant has established a reduction to practice prior to August 26, 1997 by the 37 C.F.R. 1.131 declaration (see Response of June 6, 2005) which antedates the remaining applications to which the '924 patent claims priority. This declaration was accepted by the Examiner to overcome Knudsen et al ("The declaration and Exhibits filed on June 8, 2005 and June 13, 2005 under 37 CFR 1.131 is sufficient to

overcome the Knudsen et al., 6,458,924 reference.” Paper No. 082105, page 2). As such, Applicant submits that the Knudsen et al is not prior art to the present invention and the rejection is therefore moot.

For the Examiner’s convenience, Applicant has reproduced the arguments filed on December 15, 2005 regarding the unavailability of the ‘924 patent as prior art.

Knudsen et al. cannot be used as prior art to Applicant’s Claims

1. Knudsen et al. priority applications, ‘255 and ‘226, do not suggest or disclose “tween surfactants”

Applicant has reviewed the ‘255 and ‘226 applications and submit that there is no disclosure or suggestion of “tween polymeric surfactant” provided by the ‘255 and the ‘226 applications. The ‘255 and the ‘226 applications therefore, do not properly support the subject matter relied upon by the Examiner under 35 U.S.C. 112, first paragraph, and as such, the subject matter is not entitled to the filing dates of these applications. As Applicant has antedated the remaining applications to which Knudsen et al. claims benefit with the 37 CFR 1.131 Declaration and Exhibits filed on June 8, 2005 and June 13, 2005, the subject matter relied upon by the Examiner does not have an effective filing date prior to Applicant’s reduction to practice. Therefore, Knudsen et al. is not prior art to the Applicant and cannot be relied upon by the Examiner in making the rejection under 35 U.S.C. § 102(c).

2. Knudsen et al. cannot properly claim priority to the ‘904 application

Applicant submits that Knudsen et al. cannot properly claim priority to the ‘904 application because there is no common inventor between the ‘904 application and Knudsen et al as required by 35 U.S.C. 119(c)(1). 35 U.S.C. 119 (c)(1) states:

(c)(1)An application for patent filed under section 111(a) . . . for an invention disclosed in the manner provided by **the first paragraph of section 112** of this title in a provisional application filed under section 111(b) of this title, **by an inventor or inventors named in the provisional application**, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed (emphasis added)

A review of US 60/035,904 indicates that the inventors are

Alan D. Wiley,
Anthony Harriman,
Brian Jeffreys, and
David W. Ingham

The inventors listed on Knudsen et al. are

Lisolette Bjerre Knudsen,
Per Olaf Humsfeldt, and
Per Franklin Nielsen.

As there are no common inventors between the '904 application and Knudsen et al., Knudsen et al., cannot properly claim priority to the '904 application under 35 U.S.C. 119(e)(1) and as such cannot be relied upon by the Examiner.

As Knudsen is not prior art to the Applicant, the rejection is moot. Applicant respectfully requests withdrawal of the rejection and passage of the claims to allowance.

Conclusion

Applicant believes that the rejections submitted by the Examiner have been traversed and respectfully ask that the Examiner allow all pending claims.

Respectfully submitted,

/Alejandro Martinez/
Alejandro Martinez
Attorney for Applicant
Registration No. 58,163
Phone: 317-277-4260

Eli Lilly and Company
Patent Division/GAC
Lilly Corporate Center
Indianapolis, Indiana 46285

December 6, 2006